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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/501,600 02/10/00 KOUNO

Y 105398

EXAMINER

MM91/0515

Oliff & Berridge PLC  
P O Box 19928  
Alexandria VA 22320

CHANG, A

ART UNIT

PAPER NUMBER

2872

DATE MAILED:

05/15/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

**Office Action Summary**

Application No.

09/501,600

Applicant(s)

KOUNO, YOUSUKE

Examiner

Audrey Y. Chang

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 March 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2,3 and 5-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,3 and 5-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Remark*

1. This Office Action is in response to applicant's amendment filed on March 26, 2001 which has been entered as paper number 7.
2. By this amendment, the applicant has amended claims 2, 3, and 5, has canceled claims 1 and 4 and has newly added claims 7-11.
3. Claims 2-3 and 5-11 remain pending in this application.
4. The rejections to claims 2 and 4 under 35 USC 112, second paragraph, set forth in the previous Office Action dated October 24, 2000 are withdrawn in response to applicant's amendment.

### *Claim Rejections - 35 USC § 112*

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "the material more expansive than a material" recited in claim 9 appears to be vague and indefinite since the cost of a material is not a permanent property of the material and it is subjected to change. This limitation is therefore not definite and renders the scope of the claim unclear.

### *Claim Rejections - 35 USC § 102*

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who

Art Unit: 2872

has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

8. Claims 5 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by the patent issued to Tsuyuki et al (PN. 6,069,651).

The reasons for rejection are set forth in the previous Office Action dated October 24, 2000.

With regard to newly added claim 11, Tsuyuki et al teaches that the housing or the filter frame (65 or 117) positions the filter unit in a plane perpendicular to the optical axis, (please see Figures 6, 12 and 117). This reference has therefore anticipated the claims.

*Claim Rejections - 35 USC § 103*

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2-3, and newly added claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the patent issued to Tsuyuki et al in view of the patent issued to Weng (PN. 6,011,661).

Tsuyuki et al teaches an imaging apparatus for endoscopes wherein the imaging apparatus comprises a charge couple device (CCD) (16) serves as the photoelectric conversion device that converts an object image formed on the receiving surface of the CCD to an electrical signal. The object image is projected from an endoscope (1), via a lens barrel or an imaging optical system (58 or 6) to the CCD. Tsuyuki et al teaches that a filter unit (59 and 61 or 10) is interposed between the CCD and the lens barrel or the imaging optical system wherein the filter unit are held within a housing or filter frame (65 or 117), serves as the holding member, with a stage formed at a portion of an external circumference of the optical

Art Unit: 2872

filter unit for holding the filter unit, (please see Figures 6-7, 11-12, 13A, 19, 26 and 27, columns 8-9, 10, 12, 16, and 22).

Tsuyuki et al also teaches that the filter unit (59 and 61) comprises a plurality of filter layers including a plurality layers of quartz filter and infrared cut filter, (please see column 8). Tsuyuki et al further teaches that the filter layers in the filter unit (59, 61 or 10) may be laminated along the direction along the optical axis, (please see Figures 6 and 7). Claim 2 has been amended to include the feature of having a first and a second filter layers, in the plurality of filter layers, laminated to each other with a stage formed by varying the size of the surface of the first filter with respect to the size of the surface of the second filter along the direction perpendicular to the optical axis. The Tsuyuki et al reference does not teach such feature explicitly. Weng in the same field of endeavor teaches an optical holder for an optical apparatus that includes a CCD camera (16) wherein the holder holds a color filter unit (2) via the color filter chamber (13) to the CCD camera. Weng teaches that the color filter is attached to a window (14) for the CCD camera wherein the size of the color filter is made smaller than the surface of the window (14) to form a stage for easy holding of the filter within the holder, (please see Figures 1 and 3). It would then have been obvious to one skilled in the art to apply the teachings of Weng to form surface stages with respect to consecutive filter layers of Tsuyuki et al as an alternative manner to hold these filter layers in the endoscope apparatus.

With regard to the features concerning the materials used for the different filter layers, the cited references teaches the filter layers may contain quartz but do not disclose further concern the relative strength. However it would have been obvious to one skilled in the art to modify such since it has been held it is within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended used as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Art Unit: 2872

11. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over the patent issued to Tsuyuki et al in view of the patent issued to Stravitz (PN. 4,302,078).

The reasons for rejection are set forth in the previous Office Action dated October 24, 2000.

### *Response to Arguments*

12. Applicant's arguments filed on March 26, 2001 have been fully considered but they are not persuasive. The amended claims and newly submitted claims have been fully considered and they are rejected for the reasons stated above.

13. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the stage with specific property as described in page 15 line 21 to page 16 line 16 of the specification) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### *Conclusion*

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 2872

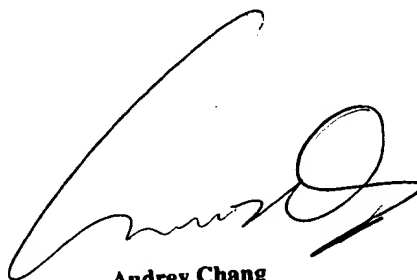
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Audrey Y. Chang whose telephone number is 703-305-6208. The examiner can normally be reached on Monday-Friday (8:00-4:30), alternative Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cassandra Spyrou can be reached on 703-308-1637. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

A. Chang, Ph.D.  
May 14, 2001

A handwritten signature in black ink, appearing to read 'Audrey Chang', with a large, sweeping initial 'A' and a stylized 'C'.

**Audrey Chang**  
**Primary Examiner**  
**Technology Center 2800**